



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,369	08/09/2000	James K. Liao	18989-004 (BWH-4)	5676

30623 7590 10/22/2002

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT PAPER NUMBER

1614

DATE MAILED: 10/22/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,369

Applicant(s)

LIAO ET AL.

Examiner

Cybille Delacroix-Muirheid

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 10-19, 21 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1614

DETAILED ACTION

1. Claims 26, 27 are rejected under 35 U.S.C. 102(a) as being anticipated by Node et al.
2. Claims 10-19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Node et al. in view of Zeldin et al.
3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Node et al. in view of Zeldin et al. as applied to claims 10-19, 25 above, and further in view of D'Amato 5,593,990 or Hammock et al., 5,955,496.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

The following is responsive to Applicant's amendment and declaration received July 10, 2002.

Claims 1-9, 20, 22-24, 29-32 are cancelled without prejudice.

No new claims are added.

Claims 10-19, 21, 25-28 are currently pending.

4. The declaration under 37 CFR 1.132 filed July 10, 2002 is insufficient to overcome the rejection of claims 10-19, 21, 25-27 based upon the Node et al. reference as set forth in the last Office action because: the declaration does not effectively establish that the Node et al. reference is no longer prior art "by another." Paragraph 3 states that Koichi Node is not an inventor with

Art Unit: 1614

respect to the claimed invention of the present application because Koichi Node carried out experiments which Dr. Liao supervised and directed. Koichi Node was listed as a co-author to receive credit for having collaborated in the research program. Therefore, it appears as if Applicant is attempting to overcome the rejections by submission of a specific declaration establishing that the article is describing applicant's own work. In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). See also MPEP 2132.01 and 715.01(c). However, the Node et al. reference, which discloses Liao's own work, is still publication "by another" since the inventors of the instant application are LIAO and ZELDIN.

With respect to paragraph 4 in the declaration, the statements in this paragraph appear to establish that Liao and Zeldin are joint inventors of the pending claims. However, it is not clear how these statements in paragraph 4 serve to establish "same inventive entity" between the Node et al. reference and the instant application.

In conclusion, the Examiner respectfully submits that the declaration does not sufficiently establish "same inventive entity" between the Node et al. reference and the instant application for the purpose of removing the reference as prior art under 102(a). Since, the Node et al. reference is a publication by another, it still qualifies as prior art under 35 USC 102(a). The rejections set forth at paragraphs 1-6 of the office action mailed March 13, 2002 are maintained.

Art Unit: 1614

Conclusion

Claim 28 is allowable.

Claims 10-19, 21, 25-27 stand rejected.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

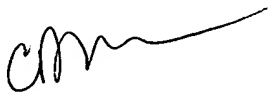
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

Art Unit: 1614

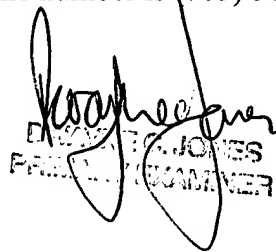
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM



Oct. 18, 2002



DAVID H. JONES
PATENT EXAMINER